

REMARKS/ARGUMENTS

Amended/New Claims

Claims 1, 8 and 13 are amended to define the norbornene-type repeat units as 4 substituted, 5 substituted or a mixture thereof. Such amendment is supported by the formulae I and Ia, hence do not constitute new matter. In addition, Claims 2, 9 and 16 are amended to change the order of the groups that define the variable Z in formulae I and Ia. Such amendment does not constitute new matter, is not made for reasons of patentability and does not change the scope of the amended claims.

Response to Priority Issue

Applicant wishes to thank Examiner Zalukaeva for the time spent in a telephonic interview conducted April 11, 2005. The subject of this interview was directed to the Priority issue raised in the Examiner's Action and during the discussion thereof it was discovered that the instant application was incorrectly identified as a Continuation Application rather than the Continuation-In-Part that is indicated in paragraph [0001] of the application. This error being discovered, Examiner Zalukaeva agreed that the instant application's priority claim, as recited in aforementioned paragraph [0001] is proper and the Priority Issue is now moot.

Rejection Under 35 U.S.C §102(b)

The Examiner states that Claims 1-3, 8, 9, 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaimoto et al (U.S. 5,585,219). Applicant traverses.

For a rejection under 35 USC §102 to be properly made and sustained, the art cited in that rejection must disclose each and every element of the claim(s) called out in the rejection.

MPEP §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.1987).

Kaimoto does not meet this requirement. Specifically, Kaimoto, as admitted to by the Examiner, recites a "copolymer of a 2-norbornene-2-substituted unit" where the claims of the instant application recite a norbornene-type repeat unit or a norbornene-type monomer that is 4 and/or 5 substituted.

While Applicant has amended Claims 1, 8 and 13 to specifically recite that the norbornene-type repeat unit or monomer is a 4 and/or 5 substituted moiety, Applicant directs the Examiner to Claims 2, 3, 9 and 16 where such element is originally present. Further, Claims 14 and 15, depending directly or indirectly from Claim 13, include the aforementioned recital through their dependency.

Thus, since it is shown above that Kaimoto fails to meet the requirement of a rejection under §102(b) for any of Claims 1-3, 8, 9 and 13-16, Applicant respectfully requests withdrawal of such rejection.

Rejections Under 35 U.S.C. §103(a)

Kaimoto in view of Sen et al (U.S. 6,111,041)

The Examiner states that Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaimoto in view of Sen et al (US 6,111,041). Applicant traverses.

Applicant respectfully points out that the '041 patent cited in the Examiner's rejection is within the chain of priority properly claimed by the instant application. Therefore, since the instant application is owned and/or commonly assigned with the '041 patent and since there is at least one common inventor, the '041 patent cannot be a reference used in a rejection under 35 USC §103. It follows then that the rejection of Claims 10 and 11 must be withdrawn, such action being earnestly requested.

Kaimoto in view of Rhodes et al (U.S. 6,232,417)

The Examiner states that Claims 4-7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaimoto in view of Rhodes et al (U.S. 6,232,417). Applicant traverses.

Specifically, the Examiner's statement that "Kaimoto does not disclose the presence of one of dissolution modifier, quencher or sensitizer," impliedly alleges that Kaimoto does disclose the other elements of Applicant's invention as recited in Claim 4. However, as previously discussed with respect to the §102 rejection based on Kaimoto (these remarks are incorporated herein) it is shown that Kaimoto does not teach all of the elements of Claims 1-3 (as amended) that through dependency are incorporated into Claim 4.

Further, Applicant respectfully asserts that Kaimoto does not suggest the limitations of the claimed invention absent from the Examiner's admission. Rather, Kaimoto's polymers are limited to those that include repeat units formed from 2-norbornene-2-carbonitrile and 2-norbornene-2-chloride. No other norbornene-type monomers are mentioned in the disclosure of Kaimoto nor is there any indication that the use of another type of norbornene-type monomer is even possible, yet alone suggested. Referring to Synthetic Examples 1 and 2, only the carbonitrile substituted compound is exemplified therein. Applicant believes that such limited exemplification is additional indication that Kaimoto intended to be limited to only the norbornene monomers specifically mentioned. Hence, Applicant believes it must follow then that absent any broadening disclosure or even any words that suggest broadening is possible, Kaimoto is limited to the two norbornene-type monomers it discloses and can not be said to suggest the 4 and 5-substituted norbornene-type monomers, such as recited in amended Claims 1 and 8, of the instant application. Further Applicant respectfully asserts that one of ordinary skill in the art would know that Kaimoto's limiting the type of norbornene monomer to ones that are 2-substituted with strong electron withdrawing groups such as CN and Cl, is a necessary limitation in that absent such substitution, the method of polymerization taught by Kaimoto would be nonfunctional and the exemplified polymers nonexistent.

While Rhodes et al., does disclose much if not all of what the Examiner alleges it discloses in the rejection of Claim 4, such does not have additional disclosure that will provide a remedy to the deficiencies of Kaimoto as shown above. Hence it follows that Kaimoto in view of Rhodes do not teach or suggest

all of the elements of the invention recited in Claim 4 and such must be withdrawn. Action to this effect is requested.

Referring now to the rejection of Claims 5-7 and 12, Applicant refers to the discussion above regarding the rejection of Claim 4, and respectfully asserts that at least for those reasons Kaimoto in view of Rhodes does not meet the requirement to sustain a rejection under §103. Again it follows that such rejection must be withdrawn.

Summary

In summary Applicant again thanks the Examiner for her prompt response to the request for a telephonic interview. In addition, Applicant respectfully requests reconsideration of the rejections of Claims 1-16 in view of the remarks/argument presented above. As Applicant believes such claims are in condition for allowance, such action is requested. Should, however, the next action be anything other than a Notice of Allowance, Applicant invites the Examiner to contact Bernard Berman, Esq. at the telephone number noted below prior to filing such an action in an effort to expedite this prosecution.

Respectfully submitted,

Dated: April 12, 2005

By: 
Bernard Berman, Esq.
Reg. No. 37,279
c/o Hudak Shunk & Farine Co. LPA
Suite 307
2020 Front Street
Cuyahoga Falls, OH 44221

Telephone: (440) 922-1469

E-mail: bernie.berman@promerus.com